

PATENT  
Serial No.: 10/034,090  
Docket No. 30564.2  
Customer No. 000027683

### REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1-5, 7, 12, 13-20, 24-31, and 36 have been amended. Claims 11, 23, and 35 have been cancelled. Claims 37-57 have been added. Claims 1-10, 12-22, and 24-57 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims, as for example, in Figs. 2d, 2e and 2g. Accordingly, no new matter has been entered.

### Objections

The Office Action objected to the Abstract of the Disclosure. As suggested by the Office Action, Applicant has amended the Abstract of the Disclosure.

The Office Action also objected to this application because the application did not include a Background and a Summary. Applicant traverses the Office Action's requirement for a Background and a Summary in the specification on the following grounds. The applicable statute, 35 U.S.C. § 112, ¶1, does not require a Background or a Summary. Although §608.01(d) of the MPEP mentions a Background and a Summary as part of a "preferred stylized specification," and although 37 CFR § 1.73 mentions a Summary, they are permissive only and are not required.

Page 6, lines 1 and 3, and page 20, line 9 of the Applicant's specification have been amended to overcome the Office Action's objections thereto.

The Office Action objected to the Drawings as failing to comply with 37 CFR § 1.84(p)(5), because Fig. 1a includes an "element 100a" which is not referenced by the written description. Accordingly, Applicant's specification has been amended to overcome such objection.

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**Rejection of the claims**

The Office Action rejected claims 1, 13, and 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0084046 A1 ("Roger") in view of U.S. Patent No. 6,363,392 ("Halstead").

As amended, Claim 1 recites:

1. A system, comprising:  
a computer system for:  
through a network, providing a plurality of templates to a user;  
through the network, receiving a selection from the user of at least first and second templates of the plurality of templates; and  
generating a database including information of the selected first and second templates.

As amended Claim 13 recites:

13. A method, comprising:  
through a network, providing a plurality of templates to a user;  
through the network, receiving a selection from the user of at least first and second templates of the plurality of templates; and  
generating a database including information of the selected first and second templates.

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As amended, Claim 25 recites:

25. A computer program product, comprising:  
a computer program processable by a computer system for causing the computer system to:  
through a network, provide a plurality of templates to a user;  
through the network, receive a selection from the user of at least first and second templates of the plurality of templates; and  
generate a database including information of the selected first and second templates; and  
an apparatus from which the computer program is accessible by the computer system.

As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness..." Moreover, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Also, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to amended claim 1, Roger and Halstead are defective in establishing a *prima facie* case of obviousness. In fact, unlike amended claim 1, Roger and Halstead instead teach away from the combination of: receiving a selection from a user of at least first and second templates of a plurality of templates; and generating a database including information of the selected first and second templates. For example, Roger teaches away from the combination of elements in amended claim 1, because the Office Action acknowledged that Roger explicitly fails to "teach generating a database including the

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template selected by the user.” Moreover, the cited portion of Halstead discloses providing a single template to a user, but not a plurality of templates, so Halstead likewise teaches away from the combination of elements in amended claim 1.

Accordingly, as between Roger, Halstead and Applicant’s specification, only Applicant’s specification teaches the combination of elements in amended claim 1. Thus, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant’s teachings in its own specification. Therefore, the PTO’s burden of factually supporting a *prima facie* case of obviousness has not been met.

In relation to amended claims 13 and 25, Roger and Halstead are likewise defective in establishing a *prima facie* case of obviousness.

Thus, a rejection of amended claims 1, 13 and 25 is not supported.

**Conclusion**

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 13, and 25

Dependent claims 2-10, 12, and 37-43 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 14-22, 24, and 44-50 depend from and further limit claim 13 and therefore are allowable.

Dependent claims 26-34, 36, and 51-57 depend from and further limit claim 13 and therefore are allowable.

An early formal notice of allowance of claims 1-10, 12-22, and 24-57 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 08-1394.

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Applicant has made an earnest attempt to place this case in condition for allowance.  
If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the  
telephone number listed below.

Respectfully submitted,



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